REMARKS

Please make of record the following remarks, responding, in order, to the identified sections of Examiner's June 3, 2003 Office Action (Paper 8).

Response to Amendment

Applicant acknowledges Examiner's withdrawal of the objection to the drawings and requests that Examiner update Item 10 on the Office Action Summary to indicate that Examiner's objection has been withdrawn

Response to Arguments C 4, L. 25 - 35

Freedman Print Facility Cannot Print Product -C. 10, L. 24 - 32.

Applicant respectfully disagrees with Examiner's assertion that Freedman (U.S. Patent 4,839,829) discloses a means to produce a printed work. While Freedman discloses a printer facility terminal 36 that includes a printer 40, Freedman nowhere suggests that the printing job can be printed using said printer. Printer 40 is used only to print out only a "verification of the [printing] parameters, prices, etc." (column 10, lines 33-35) in the case of the printing requester, or "a preliminary estimated invoice to the customer" (column 12, lines 38-41) and "the 'job jacket' which moves along with the printing job through the various stages of the printing process" (column 13, lines 10-13) in the case of the printing facility.

Both the present invention and the Freedman device contemplate the printing of high-quality commercially-printed products using advanced printing production methods, such as engraving, embossing, lithography, and the like. These are not the type of products that can be produced simply by using a standard printer of the type disclosed by Freedman. Thus, Examiner's conclusion that "it would have been obvious to output the print job to these printing terminals, which include printer 40 for printing of the job," is unsupported by the prior art and, thus, is erroneous. The printer 40 disclosed by Freedman cannot produce engraving, embossing, lithographed products and, moreover, Freedman includes no enabling disclosure on how such could be accomplished.

Applicant submits that Examiner's contention that the Freedman printer 40 would have been capable of producing commercially-printed products, such as engraved, embossed, or lithographed letterhead, business cards, envelopes and the like, suggests that Examiner may not fully understand or appreciate the nature of Applicant's invention and/or the complexities of the commercial printing industry. As described in detail in Applicant's specification, products manufactured using Applicant's invention require specialized machinery, not simple dot matrix or laser printers. Even Freedman acknowledges that specialized machinery is required to produce the products (e.g., column 10, lines 22-24 and 61, column 13, lines 13-16). Clearly, it was not as simple and obvious as "outputting a print job to [a] printing terminal."

Freedman Does Not Produce Output Designed by Template

Applicant also respectfully traverses Examiner's conclusion that "Freedman teaches selection of printing templates that have been established and then loading the printing data into the template *for output as designed by the template* [emphasis supplied]." This is a critical misinterpretation of the Freedman disclosure. **Printing data is not loaded into the Freedman template.** In fact, Freedman's use of the word "template" is deceiving, for, unlike Applicant's invention, Freedman's template does not accept data. As Freedman actually discloses, the printing data is loaded "into the *computer* [emphasis supplied]" (column 8, lines 45-47), not into a template. A user's choice of template is one of the variables that the Freedman device uses when it calculates how much a printing job will cost. However, it simply is erroneous to conclude that printing data is loaded into Freedman's template when Freedman's specification proves otherwise.

Additionally, Examiner's implication that Freedman produces output as designed by the template also is ill-founded. As explained in Applicant's prior responses, Freedman does not disclose, teach, or suggest a device that actually creates a final product ready for printing. If Freedman were capable of producing output as designed by the template, there would be no need for Freedman's device to require a printing facility, for the print requester could simply print the output on the print requester's printer.

Moreover, if Freedman were capable of producing output as designed by the template, there would be no need for Freedman's device to generate "additional information to facilitate the *actual printing of the work* [emphasis supplied]" or "machine settings which may be directly or manually applied to graphic machines" (column 13, lines 8-16). **Freedman does not actually produce** C.9, L.64- 67 **formatted output ready to be printed; instead, Freedman provides data to assist with** C.10 & L.19-35 **printing a work—this is a fundamental distinction**. Freedman sends data—the raw, unformatted text and graphics, the desired formatting parameters, the desired layout parameters, the desired output parameters—to a third-party printing facility that, independent of Freedman's device, but based on the data and parameters provided by Freedman's device, actually formats the text and graphics using prior art methods not disclosed by Freedman (and not relevant to Freedman's device) and produces the final product. It is this third-party printing facility data formatting and product production process that Applicant's invention automates.

Examiner is respectfully requested to again review the Freedman disclosure and reconsider the objections in light of the amended claims as described below.

<center>*Claims*</center>

Applicant respectfully traverses Examiner's continued rejection of Claims 1 – 5 and 7 – 9 under 35 U.S.C. 102(b) as being anticipated by Freedman. In light of the preceding remarks, Examiner is requested to reconsider and withdraw the rejections.

Claim 1

To anticipate a claim, **the cited reference must teach every element of the claim.** MPEP §2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Id. citing Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown as in complete detail as is contained in the … claim." *Id. citing Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant's Claim 1, as read in light of Applicant's specification, includes specific, positive limitations that are not taught or suggested by Freedman. Therefore, Applicant's Claim 1 is allowable.

Specifically, Applicant's automated typesetting system, as described in Claim 1, comprises, *inter alia*, a:

> means for automatically formatting said populating data on said electronic graphic template according to said customer's corporate identity specifications to form a populated and formatted template,

Examiner has taken the position that Freedman automatically formats populating data on an electronic graphic template. Examiner claims support for that position is found in Freedman's statement that "The computer provides the requester with a number of possible formats which could be selected. The formats made available for section are typical of those employed in the printing industry or to a particular customer or type of work" (column 8, lines 40-44). However, as discussed above, Examiner's reading of the Freedman disclosure accords it far more breadth that it is actually entitled.

Applicant and Freedman use similar words ("template" and "format") to describe different elements of related processes and it is crucial that Examiner read the disclosures carefully and assign the correct meanings the words. Simply because the word "format" (noun) appears in the Freedman disclosure does not mean that Freedman "formats" (verb). In fact, Freedman's formats (also called "templates") are static design layouts that do not accept text or graphics and are used only to help determine the cost of a printed product. On the other hand, Applicant's device includes electronic graphic templates that *do* accept text and graphics and Applicant's device formats (verb) the text and graphics on the templates.

A "means for automatically formatting" requires that the device actually, affirmatively, perform the function of formatting (verb). It is well known that a patent applicant can be his own lexicographer provided the applicant's definition, to the extent it differs from the traditional definition, is clearly set forth in the specification. *Beachcombers Int'l, Inc. v. WildeWood Creative Prods., Inc.*, 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994). Examiner is required, therefore, to examine Applicant's specification for the proper scope and definition of the word "formatting" as used in the phrase "means for automatically formatting." Applicant's intended meaning of the word "formatting" is found it the specification:

[handwritten margin notes: C.9, 1 / L.30-35 / L.36-41 / Use of publication Design. Specified is considered to perform formatting of information.]

After the populating data is entered into the first block of the template, the various design specifications for that block, such as kerning, leading, font styles, font sizes, colors, etc., are adjusted. This is accomplished by programming the design specification commands into the Database File Program's calculation field. Using the appropriate PageMaker commands, such as "select," "textedit," "textselect," "font," "sizebump," "KernText," and "Color," as shown in the BCard01 calculation field in Fig. 7 and in the appended unabridged sample Database File Program, FileMaker Pro instructs PageMaker to select the appropriate x-and-y coordinates of the block that needs to be adjusted, resets PageMaker into a text edit mode, and transmits to PageMaker the commands necessary to complete the desired **formatting**. For example, to set the kerning for a given text block, PageMaker is instructed by FileMaker Pro to set the cursor within the appropriate text block (identified by its x-and-y coordinates), highlight the text that needs to be kerned, and adjust the kerning as required. The design parameters are based on a customer's corporate identity specifications as programmed into the Database File Program.

The present invention can set any **formatting** that a human operator could set manually. The great advantage is that a human operator could accidentally move or change something incorrectly, where the present invention cannot—it only moves or adjusts the data it is programmed to change.

When the first set of x-and-y coordinates have been fully populated and formatted, Database File Program's calculation field is programmed to continue on to the x-and-y coordinates of the next block on the template and perform the identical functions as stated above for the populating of the block and the **formatting** of the populating data according to the programmed design specifications. Once all of the populating data from the first found record is populated and formatted, the Template Populating Script instructs FileMaker Pro to move on to the next found record and to repeat the process for the next set of blocks

on the template (for example, BCard02), as shown in Fig. 7 and in the appended unabridged sample Template Populating Script. Only after all of the populating data from all of the found records have been fully populated with all **formatting** design specifications followed, is PageMaker instructed by FileMaker Pro (using the "printoptionsps" and "print" commands, as shown in Fig. 14) to send the template direct to the appropriate device, either directly connected or connected over a computer network using standard, prior art networking technology, for the manufacture of production-ready plates or films.

(Specification, pages 15 – 16 [emphasis supplied]).

Freedman does not disclose any comparable manner of formatting (verb) text and graphics on an electronic graphic template. It is true that Freedman *collects* formatting parameters, such as typeface, point size, characters per pica count, leading, and the like, as described in column 8, lines 56 – 68. However, *Freedman does not apply the formatting parameters to any text or graphics.* Instead, Freedman simply uses the formatting parameters that it collects as variables in a formula to calculate "cost information utilizing alternate pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities" and provide "information regarding the various job costs, timing, etc. and is given the opportunity to select a particular printing facility or a particular machine or mix of machines for production of the job." (Freedman, column 10, lines 16 – 24).

Freedman teaches no means for automatically formatting populating data on an electronic graphic template according to a customer's corporate identity specifications to form a populated and formatted template. Applicant can find no disclosure in Freedman analogous to applicant's above-described (Specification, pages 15 – 16) automated means of selecting unformatted data on an electronic graphic template, applying the appropriate formatting to the unformatted data according to a customer's corporate identity specifications, and similarly selecting and formatting the next unformatted data on the electronic graphic template until all unformatted data has been appropriately formatted according to the customer's corporate identity specifications.

Allowing a user to select a "manuscript status format [noun]" (Freedman, column 8, lines 36 – 44) and collecting from a user "custom design format [noun]" information (Freedman, column 8, lines 56 – 68) are not means for automatically formatting as taught by Applicant's Claim 1 read in light of Applicant's specification. Freedman's device does not format (verb). Therefore, at a minimum, this element of Applicant's Claim 1 is not anticipated by Freedman, and the claim is allowable.

Claim 2

Applicant respectfully traverses Examiner's rejection of Claim 2 under 35 U.S.C. 102(b) as being anticipated by Freedman and requests Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros.*, 2 USPQ2d at 1053. "The identical invention must be shown as in complete detail as is contained in the … claim." *Richardson*, 9 USPQ2d at 1920. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." 37 C.F.R. 1.75(c).

Dependent Claim 2 teaches the automated typesetting system as recited in Claim 1. As discussed above, Freedman clearly does not anticipate Applicant's Claim 1, as Freedman does not teach each and every element and limitation of Claim 1, most specifically, a means for automatically formatting populating data on an electronic graphic template according to a customer's corporate identity specifications to form a populated and formatted template. Therefore, Freedman does not teach each and every element of dependent Claim 2 and Claim 2 cannot be anticipated by Freedman.

Moreover, Examiner's contention that Freedman discloses "a means for automatically printing said populated and formatted template" (column 7, lines 58-61 and column 8, lines 45-48) is incorrect. Freedman discloses a means for transmitting the data and parameters it receives to a third-party printing facility. Transmitting text, graphics, and layout and formatting parameters is far different from printing a template with text and graphics that have had formatting and layout parameters applied to them.

Examiner is respectfully requested to reconsider and withdraw the rejection.

Claims 3 – 5 and 7 – 9

Applicant respectfully traverses Examiner's rejection of Claims 3 – 5 and 7 – 9 under 35 USC 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829) and requests Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros.*, 2 USPQ2d at 1053. "The identical invention must be shown as in complete detail as is contained in the ... claim." *Richardson*, 9 USPQ2d at 1920. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." 37 C.F.R. 1.75(c).

Dependent Claims 3 – 5 and 7 – 9 teach the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not anticipate Applicant's Claims 1 or 2, as Freedman does not teach each and every element and limitation of Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claims 3 – 5 and 7 – 9 and Claims 3 – 5 and 7 – 9 cannot be anticipated by Freedman.

Additionally, with regard to Claim 8, Examiner argues that the Freedman print manager's selection of "standard or floor stock" and the print manager's "ability to add additional information in the computer such as special stock dimension, color or plate size to complete the job" (column 11, line 36 to column 12, line 11) is the equivalent of Applicant's "means for automatically populating said populating data into said electronic graphic template further compris[ing] a means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template." Applicant can find no support for Examiner's contention. The cited section of the Freedman specification contains no mention of a template or a means to fully populate the template should the populating data not fully populate the template. Examiner is respectfully requested to reconsider and withdraw the rejection.

Claim 6

Applicant respectfully traverses Examiner's rejection of Claim 6 under U.S.C. 103(a) as obvious based on Freedman in view of Cupps et al. (U.S. Patent 5,991,739). To establish a *prima facie* case of obviousness under 35 U.S.C. 103, three basic criteria must be met: there must be some suggestion or motivation to modify the reference or combine the references, there must be a reasonable expectation of success, and **the prior art reference must teach or suggest all the claim limitations.** MPEP §706.02(j). "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." 37 C.F.R. 1.75(c).
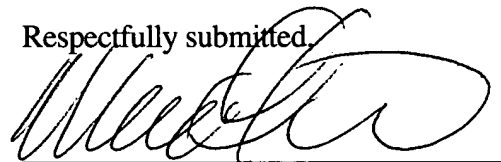
Dependent Claim 6 teaches the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not teach or suggest all the claim limitations in Applicant's Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claim 6 and Claim 6 cannot be anticipated by Freedman. Since Freedman does not teach or suggest all of the claim limitations of Claim 6, a *prima facie* case of obviousness under 35 U.S.C. 103 cannot be made. Therefore, Applicant's dependent Claim 6 would not have been obvious to one of ordinary skill in the art of automated typesetting systems, and Claim 6 is patentable over Freedman in light of Cupps et al. Examiner is respectfully requested to reconsider and withdraw the rejection.

CONCLUSION

With this Amendment, Applicant believes that the application is in condition for allowance and an early issuance of the Notice of Allowability is respectfully requested.

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Respectfully submitted,

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